

REMARKS

Claims 9-25 are pending in the present application.

Reexamination of the application and reconsideration of the rejections and objections are respectfully requested in view of the following remarks, which follow the order set forth in the Office Action.

I. Obviousness-type Double Patenting

The Office Action alleges that claims 9-25 are unpatentable over claims 15-33 of co-pending application No. 10/581,109. Applicants respectfully point out that this rejection should be a provisional rejection because no claims have been allowed in either case.

According to the MPEP, the provisional rejection should:

continue to be made by the examiner in each application as long as
there are conflicting claims to more than one application unless
that provisional double patenting rejection is the only rejection
remaining in one of the applications.

MPEP, 8th Ed., Revision 6, September 2007, § 804.I.B.

Moreover, Applicants respectfully disagree with the reasoning set forth in the Office Action. It would not have been obvious to use a non-crop pesticide on seeds used in agriculture. The co-pending application states, “[a]ctivity of a compound against pests for plant protection in the agricultural field, that is, against crop pests, does not generally suggest activity of that compound against non-crop pests.” Page 4, lines 23-25. The Office Action neither specifically addresses the distinction between crop pests and non-crop pests nor provides a rationale underpinning as to why non-crop pests would be a pest found on seeds in the first place. Applicants respectfully request reconsideration and withdrawal of the rejection.

II. Claim Rejections Under 35 U.S.C. § 103

Claims 9-28 have been rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Furch *et al.* (US Patent No. 5,420,165) (“Furch”) in view of Nakagami *et al.* (US Patent No. 4,304,778) (“Nagakami”). OA, p. 4. Applicants respectfully traverse this rejection.

All of the present claims are directed to either a method of protecting seeds by contacting the seeds with a compound of Formula I, or to the seeds themselves. The present application discloses that:

Activity of compounds in plant protection against agricultural pests does not suggest their suitability for the protection of seeds which requires, for example, activity against soil pests, compatibility with the soil conditions (e.g. concerning binding of the compound to the soil), negligible phytotoxicity when applied to the seed, and appropriate movement to achieve necessary bioavailability (in soil or plant).

* * *

Surprisingly it has now been found that compounds of formula I are suitable for the protection of seeds.

Page 2, lines 25-32.

To establish a *prima facie* case of obviousness, first, there must be some suggestion or motivation, either in the references themselves or in the knowledge in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success *and* third, all claim limitations must be considered. *See* MPEP § 2143. All of these criteria have not been met for the following reasons.

There is no suggestion that the Nagakami compounds protect seeds against pests. In proper context, the seed-protecting compounds in Nagakami are disclosed as also having fungicidal and/or bactericidal activity. At page 5, the Office Action cites the abstract and column 2, lines 1-5, and in the corresponding text of each of these citations, Nagakami discloses that the compounds have fungicidal and/or bactericidal activity. The fungicidal aspect of Nagakami is also recited throughout the patent's text and in the patent's title. It does not appear that in proper context Nagakami teaches that applying compounds to seeds affords on the one hand protection against infectious diseases, and equally as well on the other hand, protection against insects and mites. Rather, according to Nagakami, when the compounds are used on seeds, it is only for control of infectious diseases. Nagakami states: "The compositions of the invention, *when employed for seed disinfection or coating*, effectively control soil-borne or seed infectious diseases by coating seeds...." Column 8, lines 32-35, (Emphasis added). At page 5, the Office Action states that:

Although Furch et al. do not specifically teach applying the instant compounds to seeds, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the instant

compounds to seeds as well as to soil or plants for protection against insects and mites as suggested by Nagakami et al.

In proper context, however, there is no suggestion in Nagakami that applying compounds to seeds protects the seeds from anything but infectious diseases. In view of this, the Office Action has not met the burden of showing an “articulated reasoning with some rational underpinning to support the legal conclusion.” (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in KSR). For at least this reason, the Office Action fails to establish a *prima facie* case of obviousness.

Even if Furch and Nagakami were to be combined, Applicants submit that in the proper context discussed above, there would have been no reasonable expectation of success in arriving at the present method or seeds. In proper context, Nagakami only teaches applying compounds to seeds when those seeds are to be protected from infectious diseases. According to the Office Action, Furch does not disclose applying compounds to seeds at all. OA, p. 5 & 6. Nevertheless, the Office Action alleges that one of ordinary skill in the art, “would have applied the instant compounds to any area that may be affected by insect or mite infestation for the purpose of obtaining maximal protection against said pests.” OA, p. 6. However, “[a]ctivity of compounds in plant protection against agricultural pests does not suggest their suitability for the protection of seeds....” Present specification, page 2, lines 25-26. Thus, the combination of Nagakami and Furch would at best lead one of ordinary skill in the art to expect that applying a fungicide or bactericide, which may also possess some insecticidal activity, to a seed could protect the seed from infectious disease. One of ordinary skill in the art would not have been led to reasonably expect that applying a compound of Furch to a seed would result in protection *from pests*. Moreover, because the compounds of Furch have no reported infectious disease activity, it could not have been reasonably expected at the time of filing the present application that such compounds would even work at all in the method of Nagakami, which states seed disinfection or coating is effective for control of infectious diseases. For at least this reason, the Office Action fails to establish a *prima facie* case of obviousness.

In view of the above, reconsideration and withdrawal of the rejection of claims 9-28 is respectfully requested.

CONCLUSION

For the foregoing reasons, all of the pending claims are considered allowable. A Notice to this effect is respectfully requested. If any questions remain, the Examiner is invited to contact the undersigned at the number given below.

Respectfully submitted,

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Date: July 30, 2008

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